

## **REMARKS**

The Examiner rejected claims 56-60 and 62-87, while apparently withdrawing claims 88-106 from further consideration. Thus, claims 56-60 and 62-106 are pending. Applicants note that the Examiner appears to have inadvertently omitted claim 106 from the list of pending and withdrawn claims.

Claims 56-60 and 62-88 have been amended herein to recite a membrane penetrating non-hypodermic needle. Applicants' specification fully supports these amendments. For example, page 9, lines 1-2 disclose that the needle is a needle "not intended to penetrate directly in skin and/or tissue of a patient." Thus, no new matter has been added.

In light of these amendments and the following remarks, Applicants respectfully request reconsideration and allowance of claims 56-60 and 62-87. Applicants also respectfully request rejoinder, examination, and allowance of claims 88-106.

### Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 56-60 and 62-87 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of the Henderson reference (U.S. Patent No. 3,064,651) and the Hickey reference (U.S. Patent No. 2,697,438) alone or in combination with one or more of the following references: the Haindl reference (U.S. Patent No. 4,889,529), the Bittner reference (U.S. Patent No. 5,515,871), the Kaneko reference (U.S. Patent No. 6,517,523).

Applicants respectfully disagree for at least the reasons of record. The combinations of references do not render the previously presented claims obvious. To further prosecution, however, claims 56-60 and 62-87 have been amended herein to recite membrane penetrating non-hypodermic needles. At no point do the Henderson and Hickey references disclose membrane penetrating non-hypodermic needles. In fact, both the Henderson reference and the Hickey reference disclose hypodermic needles. Thus, the presently pending claims are patentable over the combinations of cited references.

This is particularly true given the differences between hypodermic needles and the presently claimed membrane penetrating non-hypodermic needles. A hypodermic needle is a hollow needle commonly used with a syringe to inject substances into the body of a human or an animal or to extract fluids from the body of a human or an animal. They also may be used to

take liquid samples from the body, for example, taking blood from a vein. The presently claimed needles, on the contrary, are membrane penetrating non-hypodermic needles designed to penetrate the membrane of a fluid container, such as a vial, to inject a substance into the fluid container or to extract a liquid therefrom. Non-hypodermic needles are blunter and require a larger force to be pushed through a membrane, as compared to hypodermic needles, since the problem of minimizing pain inflicted on a patient to the greatest possible extent does not have to be considered with a non-hypodermic needle.

Moreover, a person having ordinary skill in the art would not have considered the teachings of the Henderson or Hickey references, which disclose hypodermic needles, if that person was somehow motivated to improve a non-hypodermic needle for the simple reason that non-hypodermic needles do not have to be designed in a way that minimizes pain inflicted on a patient to the greatest possible extent when in use. Nevertheless, even if a person having ordinary skill in the art would have been motivated to consider the teachings of the Henderson and Hickey references, there is nothing in the Henderson reference or the Hickey reference to prompt an ordinary skilled person to combine the rounded edges of the needle disclosed in the Henderson reference with the position of the needle point disclosed in the Hickey reference. On the contrary, the Hickey reference leads the ordinary skilled person away from such a combination in that the Hickey reference states the following at column 2, lines 23-25: “The location of the penetrating point at the axis of the cannula also reduces the tendency to **coring by the forward edge of the surface 8**” (Emphasis added). Edge 8 of the needle disclosed in the Hickey reference is a sharp edge. For the needle disclosed in the Henderson reference, the corresponding edge (17/18) is, however, rounded and will not therefore cause coring. A person having ordinary skill in the art is therefore taught to position the needle point in the position disclosed by the Hickey reference only if edge 8 is sharp because otherwise that sharp edge 8 will cause coring. If this is not the case (i.e., if the edge 8 is rounded), there is no reason for a person having ordinary skilled in the art to position the needle point of a needle in the position disclosed by the Hickey reference.

Thus, taken together, the combinations of cited references do not render the presently claimed invention obvious.

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In light of the above, Applicants respectfully request withdrawal of the rejections of claims 56-60 and 62-87 under 35 U.S.C. § 103(a).

### **CONCLUSION**

Applicants assert that claims 56-60 and 62-87 are in condition for allowance, which action is respectfully requested. In addition, Applicants respectfully request rejoinder, examination, and allowance of claims 88-106. The Examiner is invited to telephone the undersigned attorney if such contact would expedite prosecution of this Application.

This response is timely filed, since January 22, 2011 fell on a Saturday. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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